

PTO/SB/97 (05-03)

Approved for use through 04/30/2003. OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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on January 22, 2004.  
Date

Thomas L. Evans  
Signature

Thomas L. Evans, Reg. No. 35,805  
Typed or printed name of person signing Certificate

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Information Disclosure Statement  
Statement Under 37 C.F.R. 1.704(d)  
Copy of International Search Report

Atty. Docket No. 003797.00618

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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JAN 22 2004

OFFICIAL

Atty. Docket No.  
003797.00618

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Jamie WAKEAM ET AL.

Examiner: TBA

U.S. Pat. App. No.: 10/646,472

Group Art Unit: 2661

Filed: August 21, 2003

For: ELECTRONIC INK PROCESSING

**INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to their duty of disclosure under 37 C.F.R. §1.56, Applicants bring the following documents to the attention of the Examiner in the above-identified patent application:

- (1) U.S. Patent No. 5,559,897 to Brown et al., issued September 24, 1996;
- (2) U.S. Patent No. 5,911,013 to Taniishi, issued June 8, 1999; and
- (3) U.S. Patent No. 5,394,484 to Casey et al., issued February 28, 1995.

A PTO-1449 form is included herewith listing these documents. Since this application was filed after June 30, 2003, copies of the references are not included herewith. These documents were cited in an International Search Report for a related PCT application, a copy of which is attached.

U.S. Pat. App. No.: 10/646,472  
Atty. Docket No.: 0037897.00618

The International Search Report is in English. Therefore, Applicants respectfully urge that further comment is unnecessary in accordance with 37 C.F.R. 1.98(a)(3). However, Applicants respectfully point out that the International Search Report classifies these documents in category A.

Applicants believe that no fees are required for the Examiner's consideration of the documents listed in this Information Disclosure Statement. If, however, the Commissioner deems that any fees are necessary for the filing of this Information Disclosure Statement, then the Commissioner is authorized to charge said fees to Deposit Account No. 19-0733.

It is respectfully requested that the documents listed above be considered by the Examiner in the above-identified patent application and that they be made officially of record therein. It is further requested that a listing of the same appear on the face of any patent that may issue from this application.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: Thomas L. Evans

Thomas L. Evans, Reg. No. 35,805  
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January 22, 2004

PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0851-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Substitute for form 1448A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Sheet

of

**Complete If Known**

Application Number	10/646,472
Filing Date	August 21, 2003
First Named Inventor	Jamie Wakeam et al.
Group Art Unit	2661
Examiner Name	TBA
Attorney Docket Number	003797.00618

**U.S. PATENT DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number - Kind Code <sup>2</sup> (if known)			
		5,550,997	09-24-1998	Brown et al.	
		5,911,013	08-08-1999	Taniishi	
		5,394,484	02-28-1995	Casey et al.	

**FOREIGN PATENT DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> - Number <sup>4</sup> - Kind Code <sup>5</sup> (if known)				

**OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>

Examiner  
SignatureDate  
Considered

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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JAN 22 2004  
OFFICIAL

PATENT

Atty. Docket No.  
003797.00618

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Jamie WAKEAM ET AL.

Examiner: TBA

U.S. Pat. App. No.: 10/646,472

Group Art Unit: 2661

Filed: August 21, 2003

For: ELECTRONIC INK PROCESSING

**STATEMENT UNDER 37 C.F.R. §1.704(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. 1.704(d), Applicants hereby state that each item of information contained in the attached Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the Information Disclosure Statement.

Respectfully submitted,

BANNER & WITCOFF, LTD.

January 22, 2004

By:

*Thomas L. Evans*

Thomas L. Evans, Reg. No. 35,805  
1001 G Street, N.W., 11<sup>th</sup> Floor  
Washington, D.C. 20001-4597  
Telephone: (202) 824-3000  
Facsimile: (202) 824-3001

## PATENT COOPERATION TREATY

RECEIVED

DEC 24 2003

From the INTERNATIONAL SEARCHING AUTHORITY

To:  
WILLIAM F. RAUCHOLZ  
BANNER & WITCOFF, LTD.  
11TH FLOOR  
1001 G STREET, NW  
WASHINGTON, DC 20001-4597

PCT BANNER &amp; WITCOFF

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL SEARCH REPORT  
OR THE DECLARATION

(PCT Rule 44.1)

Date of Mailing **22 DEC 2003**  
(day/month/year)

Applicant's or agent's file reference  
03797.00685

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.  
PCT/US03/26172

International filing date  
(day/month/year)  
21 August 2003 (21.08.2003)

Applicant  
MICROSOFT CORPORATION

1. ☒ The applicant is hereby notified that the international search report has been established and is transmitted herewith.

## Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34, chemin des Colombettes  
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.  
☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

## 4. Reminders

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90 bis.1 and 90 bis.3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/US  
Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (703)305-3230

Authorized officer

Heather Herndon  
Telephone No. 703-305-4700

Form PCT/ISA/220 (April 2002)

(See notes on accompanying sheet)

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 03797.00685	<b>FOR FURTHER ACTION</b>	see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No. PCT/US03/26172	International filing date (day/month/year) 21 August 2003 (21.08.2003)	(Earliest) Priority Date (day/month/year)
Applicant MICROSOFT CORPORATION		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report	
a.	With regard to the language, the international search was carried out on the basis of the International application in the language in which it was filed, unless otherwise indicated under this item.
<input type="checkbox"/>	the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).
b.	With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international search was carried out on the basis of the sequence listing:
<input type="checkbox"/>	contained in the International application in written form.
<input type="checkbox"/>	filed together with the international application in computer readable form.
<input type="checkbox"/>	furnished subsequently to this Authority in written form.
<input type="checkbox"/>	furnished subsequently to this Authority in computer readable form.
<input type="checkbox"/>	the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
<input type="checkbox"/>	the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.
2.	<input type="checkbox"/> Certain claims were found unsearchable (See Box I).
3.	<input type="checkbox"/> Unity of invention is lacking (See Box II).
4.	With regard to the title,
<input checked="" type="checkbox"/>	the text is approved as submitted by the applicant.
<input type="checkbox"/>	the text has been established by this Authority to read as follows:
5.	With regard to the abstract,
<input type="checkbox"/>	the text is approved as submitted by the applicant.
<input checked="" type="checkbox"/>	the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.
6.	The figure of the drawings to be published with the abstract is Figure No. <u>5</u>
<input checked="" type="checkbox"/>	as suggested by the applicant.
<input type="checkbox"/>	because the applicant failed to suggest a figure.
<input type="checkbox"/>	because this figure better characterizes the invention.
<input type="checkbox"/>	None of the figures

Form PCT/ISA/210 (first sheet) (July 1998)

## INTERNATIONAL SEARCH REPORT

International application No.

PCT/US03/26172

## Box III TEXT OF THE ABSTRACT (Continuation of Item 5 of the first sheet)

The technical features mentioned in the abstract do not include a reference sign between parentheses (PCT Rule 8.1(d)).

## NEW ABSTRACT

Systems, methods, and computer readable media for making rich, flexible, and more natural electronic ink annotations in an electronic document(500) include creating a first context node associated with a first portion of a base portion of an electronic document; creating a second context node associated with an annotation to the base; and linking the second context node with the first context node.

Form PCT/ISA/210 (continuation of first sheet(2)) (July 1998)



## INTERNATIONAL SEARCH REPORT

International application No.

PCT/US03/26172

## A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : G06K 9/00

US CL : 715715/512, 517, 530; 382/119

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 715715/512, 517, 530; 382/119

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 5,559,897 A (BROWN et al) 24 September 1996 (24.09.1996)	1-65
A	US 5,911,013 A (TANIISHI) 08 June 1999 (08.06.1999)	1-65
A	US 5,394,484 A (CASEY et al) 28 February 1995 (28.02.1995)	1-65

☐ Further documents are listed in the continuation of Box C.☐ See parent family annex.

## \* Special categories of cited documents:

\*A\* documents defining the general state of the art which is not considered to be of particular relevance

\*E\* earlier application or patent published on or after the international filing date

\*L\* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

\*O\* document referring to an oral disclosure, use, exhibition or other means

\*P\* documents published prior to the international filing date but later than the priority date claimed

\*T\*

later documents published after the international filing date or priority date and not in conflict with the application but cited to underpin the principle or theory underlying the invention

\*X\*

document of particular relevance: the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

\*Y\*

document of particular relevance: the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

\*Z\*

document member of the same patent family

Date of the actual completion of the international search

05 December 2003 (05.12.2003)

Date of mailing of the international search report

22 DEC 2003

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Facsimile No. (703)305-3230

Authorized officer

Heather Herndon

Telephone No. 703-305-4700

Form PCT/ISA/210 (second sheet) (July 1998)

# NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

## INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

### What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

**When ?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

### Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How ?** Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

### What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.